

THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Hearing:  
May 25, 2004

Mailed: August 24, 2004

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Reel Efx, Inc.

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Serial No. 76095249

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James C. Wray, of Law Offices of James C. Wray for Reel Efx, Inc.

Teresa Rupp, Trademark Senior Attorney, Law Office 106  
(Mary Sparrow, Managing Attorney).

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Before Seeherman, Chapman and Holtzman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 24, 2000, Reel Efx, Inc. (a California corporation), filed an application to register the mark REEL EFX on the Principal Register for goods and services ultimately amended to read as follows:

"scientific and electronic apparatus  
for producing special effects in the  
advertising and entertainment  
industries, namely, computer controlled  
stop action motion picture camera  
arrays" in International Class 9;

"apparatus for producing special effects for the entertainment and advertising industries, namely, lights, lighting, hazers, fluids for hazers, portable cooling systems, fans and inflatable and collapsible bodies sold as units with fans" in International Class 11;

"providing mechanical special effects for the advertising industry" in International Class 35; and

"providing mechanical special effects for the entertainment industry" in International Class 41.<sup>1</sup>

Registration has been finally refused as to all four classes of goods and services under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's failure to comply with a requirement to disclaim the term "EFX." Such term, according to the Examining Attorney, is merely descriptive of applicant's goods and services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed.

Registration has also been finally refused on the basis that the specimens submitted in support of the

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<sup>1</sup> Application Serial No. 76095249, filed July 24, 2000. All classes of goods and services are based on applicant's claimed date of first use and first use in commerce of 1984.

International Class 9 goods are not acceptable specimens therefor.<sup>2</sup>

Applicant has appealed, and briefs have been filed. Applicant's attorney and the Examining Attorney were present at an oral hearing held before the Board on May 25, 2004.

We turn first to the Examining Attorney's requirement for acceptable specimens for the International Class 9 goods. She contends that the specimens for goods submitted with the original application support use of the mark for the International Class 11 goods, but not the International Class 9 goods; that the substitute specimen for the International Class 9 goods is not an acceptable specimen because (i) it is an advertisement which may promote the sale of the goods, but does not support trademark use of the mark REEL EFX for the goods, and (ii) the term is not used as a trademark for these goods (MULTICAM is used as the trademark for the camera arrays) but is used only as a trade name.

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<sup>2</sup> The appeal originally included a third issue--whether applicant's identification of the International Class 11 goods was acceptable. Following the oral hearing on this appeal, applicant submitted a proposed amendment to the International Class 11 identification of these goods. The Board remanded the application to the Examining Attorney, and she accepted that identification.

Applicant contends that the catalog sheets submitted with the original application "evidenced use of the mark in all of the classes." (Reply brief, p. 2.)

It is clear from a review of the specimens of record that the original specimens for goods all relate to specific items of goods ultimately classified in International Class 11 (e.g., fans, hazers, cooling systems). Applicant did not point to any specific original specimen that it believed supported use for the International Class 9 goods, and we find none.

With regard to the substitute specimen, we agree with the Examining Attorney that the use of REEL EFX thereon is in the nature of a trade name (i.e., "REEL EFX INC. \* 5539 Riverton Avenue \* North Hollywood, CA 91601 ...") or as identifying the company rather than as the trademark for camera arrays (e.g., "Reel EFX has been working with still camera arrays since 1996. MULTICAM is the result of those years of work.").

We find that the specimens of record do not support use of the mark REEL EFX on or in connection with the identified goods in International Class 9.

Turning to the Examining Attorney's requirement for a disclaimer of the term "EFX," it is the Examining Attorney's position that the term "EFX" means "special

effects" in relation to the involved goods and services; and that "EFX" merely describes the function of applicant's goods (the goods being used to produce special effects), and it merely describes the services, namely, providing mechanical special effects to the entertainment (e.g., movies) and advertising industries. The Examining Attorney argues that when the mark REEL EFX is viewed in its entirety, the term "EFX" is an unregistrable component of an otherwise registrable mark.

As evidence in support of this position, the Examining Attorney submitted (i) printouts of several excerpted stories retrieved from the Nexis database; (ii) printouts from various Internet web pages (including applicant's); (iii) copies of several third-party registrations which contained a disclaimer of the word "effects"; and (iv) the online "Acronym Finder" showing four definitions of "EFX," the first of which is "Effects (as in motion picture special effects; sometimes just FX)." In addition, the Board takes judicial notice of the Acronyms, Initialisms & Abbreviations Dictionary (33rd Edition 2004) definition of "EFX" as "special effects."<sup>3</sup> (The only other appearance of

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<sup>3</sup> See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12 (2d ed. rev. 2004).

"EFX" in this dictionary is as the NY Stock Exchange symbol for Equifax, Inc.)

Some of the excerpted stories retrieved from Nexis to show that "EFX" is commonly understood in the relevant industries to mean "special effects" are set forth below:

HEADLINE: Springfield Joins 'EFX'  
...'EFX,' which stands for 'special effects' in a show that offers fire-breathing dragons and spaceship landings, has proven an adaptable vehicle each time it has been revamped to fit the talents of a new star. ...  
"Las Vegas Review-Journal," December 6, 2000;

HEADLINE: Entering Their 15th Year, LH&A Announces Four New Accounts  
...Representing the agency's first association with an entertainment account, LH&A will launch the introduction of celebrated nine-time Tony award winner Tommy Tune in 'EFX' at the Las Vegas MGM Grand. The critically acclaimed 'EFX' takes its name from the stage and film industries, in which 'EFX' stands for the special effects that give a production its magical punch. ... "PR Newswire," January 11, 1999;

HEADLINE: Grand Illusions; Vegas Musical a Dazzling Display of Smoke and Lasers...  
...Even those cynical of Vegas productions admit it lives up to its techno-lingo title - "EFX," as in special effects. "The Salt lake Tribune," June 8, 1997; and

HEADLINE: Centura Bank's 'Lazy Dollar' Advertising Campaign Takes Top Honors At Charlotte Addy Awards

...Charlotte-based Price/McNabb created the advertisements with the help of the same Hollywood company that brought dinosaurs to life in the movie "Jurassic Park." KNB EFX Group Inc., a special effects company headquartered in California, spent more than 100 hours building a sophisticated mechanized puppet for the spots. ... "PR Newswire" January 31, 1995.

Applicant does not dispute that "special effects" would be merely descriptive of its goods and services. However, applicant argues that the mark REEL EFX is a unitary mark and thus the disclaimer is not necessary;<sup>4</sup> that the term "EFX" acts as a source indicator as is shown even in the Examining Attorney's evidence (i.e., a Las Vegas show); that the Examining Attorney's evidence does not establish that "EFX" is merely descriptive, but rather, to the contrary, her evidence shows that "EFX" is used by applicant and others as a trademark or service mark and is not a descriptive term; and that because the Examining Attorney's Acronym Finder definition shows that there are several meanings for "EFX," the term "is capable of different commercial impressions, especially when combined

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<sup>4</sup> Applicant also argues that when considered as whole and not dissected, the mark REEL EFX is not merely descriptive. The Examining Attorney correctly pointed out that she has not held the mark as a whole to be merely descriptive. Rather, she is requiring a disclaimer of the term "EFX" because that term is merely descriptive in relation to the identified goods and services. See e.g., the Examining Attorney's brief, footnote 1; and the October 23, 2002 Office action, unnumbered page 3.

with another word such as 'REEL'" (applicant's brief, pp. 2-3).

Because we are dealing in this case with the Examining Attorney's requirement for a disclaimer of three letters as an acronym, we start with the guidance of the predecessor of our primary reviewing Court in *Modern Optics, Incorporated v. The Univis Lens Company*, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956):

While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

See also, *Avtex Fibers Inc. v. Gentex Corporation*, 223 USPQ 625 (TTAB 1984), and cases cited therein.

It is well settled that a term is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning a significant ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, whether a term is merely descriptive is

determined in relation to the goods or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The Examining Attorney has established that "efx" is readily understood to refer to "special effects," which is what applicant provides through its identified goods and services. That is, "EFX" is substantially synonymous with "special effects." On the record before us, we hold that "EFX" is a merely descriptive term in the relevant fields of providing special effects to the advertising and entertainment industries, and also in relation to the goods used to produce the special effects (e.g., camera arrays, fans, hazers). See *In re The Yacht Exchange, Inc.*, 214 USPQ 406 (TTAB 1982)(letters "MLS" held merely descriptive of applicant's listing services for yachts and boats). See generally, *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987)(Court affirmed the Board's decision requiring a disclaimer of the merely descriptive term "FirstTier" for banking services); *In re IBP, Inc.*, 228 USPQ 304 (TTAB 1985) (requirement for a disclaimer of the merely descriptive term "select trim" for pork affirmed); and *In re Truckwriters Inc.*, 219 USPQ 1227 (TTAB 1983),

aff'd unpubl'd Appeal No. 84-689 (Fed. Cir., November 1, 1984) (requirement for a disclaimer of the merely descriptive term "writers" for insurance agency services affirmed).

Nor do we agree with applicant's argument that its mark REEL EFX is a unitary mark and thus a disclaimer is unnecessary. As explained by the Court of Appeals for the Federal Circuit in *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991):

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements.

We find that the mark REEL EFX is not unitary, but rather the relevant purchasers would perceive the "EFX" portion as a separable element, referring to "special effects." See also, *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000).

**Decision:** The refusal to register the mark for the International Class 9 goods on the basis that none of the specimens shows use of the mark on or in connection with those identified goods is affirmed. The requirement under Section 6 of the Trademark Act for a disclaimer of the term

"EFX" apart from the mark as a whole is proper, and the refusal to register the mark in the absence of this disclaimer is affirmed as to all four classes of goods and services (International Classes 9, 11, 35 and 41).

However, the refusal of registration based on the disclaimer requirement will be set aside and the mark published for opposition as to International Classes 11, 35 and 41, if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer. See Trademark Rule 2.142(g). (The submission of such a disclaimer will not, however, affect the affirmance of the refusal to register the mark for the goods in International Class 9 on the specimen requirement.)